

## REMARKS

In the July 28, 2005, first Office Action in this application, the United States Patent and Trademark Office (hereinafter "the Office") rejected Claims 1-3, 5, 6, 10-15, 17-21, 23, 24, and 26-30 as being anticipated under 35 U.S.C. § 102(b) in view of the teachings of U.S. Patent No. 5,978,013 (hereinafter "Jones et al."). Claims 7 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of Jones et al., and further in view of the teachings of U.S. Patent No. 4,674,041 (hereinafter "Lemon et al."). Claims 8 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of Jones et al., Lemon et al., and further in view of the teachings of U.S. Patent No. 6,169,543 (hereinafter "Wehmeyer"). Claims 4, 16, 25, 37, and 39-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of Jones et al. Applicant affirms the election of Claims 1-30 and 37-44 for examination. Applicant traverses various Official Notices in the first Office Action and proceeds to respond without admitting to the propriety of any of the Official Notices. Independent Claims 1, 8, 9, 17, 26 and 29 have been amended to clarify the claimed invention. Claims 19, 31, 36, 37, and 41 have been amended to clarify grammatical issues. Prior to discussing in detail why applicant believes that all of the claims in this application are allowable, a brief description of the applicant's invention and a brief description of the teachings of the cited and applied references are provided. The following background and discussions of the disclosed embodiments of applicant's invention and the teachings in the cited and applied references are not provided to define the scope or interpretation of any of the claims of this application. Instead, such discussions are provided to help the Office better appreciate important claim distinctions discussed thereafter.

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## Background

The problem of losing and/or forgetting about coupons is frustrating to consumers. Thus, some of them sort and organize their coupons, such as by expiration date and/or category, to better manage their coupons. However, this can be time consuming and may defeat the money saving purpose of using coupons. Another problem is that many coupons that arrive in the mail do not provide for online redemption, so that a consumer who makes a purchase through the Internet cannot get the same discount that the consumer would receive at the merchant's physical location.

The above described problems create inefficiencies for consumers, who desire to redeem their coupons, and for merchants, who spend time and money marketing coupons to attract consumers. Accordingly, improvements are needed in the way coupons are made available to consumers and in the way they are redeemed with the merchant.

## Summary of the Claimed Invention

A method and an article of manufacture is provided. In accordance with one aspect of the claimed invention, an article of manufacture comprises a machine-readable medium having stored thereon instructions to correlate information, related to a television program on a first channel of an interactive video casting system, with data related to coupons available on a second channel. The medium further comprises instructions, based on a correlation result, to present information related to a coupon to a client terminal. The medium further comprises instructions to respond to a request received from the a user in response to the information presented and allow the user to redeem the coupon on a channel different from the second channel. There are many other aspects of the claimed invention and for brevity purposes will not be presented here in full.

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#### Summary of Jones et al.

The system of Jones et al. focuses on processing coupon information stored in a memory at a cable television station. The cable television station may simultaneously transmit multiple video signals, each representing different sources of television programming, over multiple television channels on the cable network. The video signal may at times, such as during a product advertisement or other offer, include an embedded coupon identifier. A coupon subsystem at the cable television station monitors each video signal and retrieves coupon information from a database when it detects a corresponding embedded coupon identifier and embeds the coupon information into the video signal before transmitting it. Coupon information may be embedded using teletext standards. A subscriber unit at the television viewer's site receives the television signal and includes a teletext decoder that extracts the coupon information. The television programming aurally or visually alerts the viewer that a coupon may be generated. If the viewer actuates an input device, such as a button on a television remote control, a printer generates a coupon bearing the coupon information.

#### Summary of Lemon et al.

The system of Lemon et al. focuses on monitoring and controlling the distribution of product coupons from a plurality of remote terminals located at the point of sale is provided. The system includes video display terminals for displaying an array of coupons available for selection and means for monitoring and controlling the number of coupons distributed.

#### Summary of Wehmeyer

The system of Wehmeyer et al. focuses on customizing program guide information. The program guide information is downloaded and stored in a memory. A menu is generated based on the program guide information. The menu includes program identifiers which can be selected

by a user to implement the corresponding programs. The menu then can be customized to include identifier(s) indicative of one or more additional programs or item, including user-specific programs and items which are remotely accessed or locally accessed. After customization, the additional identifiers are selectable by the user to implement the corresponding programs or display the corresponding items. Preferably, the customization is performed locally and interactively using displays generated by an electronic host device or another device connected thereto.

### The Claims Distinguished

The Office has failed to show, and applicant is unable to find, where any of the cited and applied references, either alone or in combination, disclose the subject matter of the claimed invention. For example, none of the applied and cited references teaches "providing a notification to a user of an expiration date of a coupon separate from the expiration date printed on the coupon," as recited in Claim 1. As another example, none of the cited and applied references teaches "providing an electronic notification related to the offered coupon from the interactive video casting system subsequent to conducting the transaction, the electronic notification capable of being provided to the client terminal for display on the display screen," as recited in Claim 37. As a third example, applicant is unable to find, and the Office has failed to show, where the applied and cited references teach "providing an electronic notification related to the offered coupon from the interactive video casting system subsequent to conducting the transaction, the electronic notification capable of being provided to the client terminal for display on the display screen, the electronic notification further capable of being provided on one of the channels of the interactive video casting system that is different from the coupon channel," as recited in Claim 41.

The Office has conceded that Jones et al. fails to provide notification to the user of an expiration date of the coupon. However, the Office indicated that Claims 22 and 23 of Lemon et al. disclose as follows:

22. The system set forth in claim 1, wherein said print means includes: means for printing and dispensing a coupon bearing an expiration date.

23. The system set forth in claim 1, wherein said print means includes: means for printing and dispensing a coupon bearing a machine readable uniform product code.

Page 7 of the first Office Action.

The thrust of Lemon et al. at the cited portions is to print and dispense a coupon bearing an expiration date. The claimed invention recites "providing a notification to a user of an expiration date of a coupon separate from the expiration date printed on the coupon." It is truly a mystery how the recited claimed limitation could be disclosed by Lemon et al. Applicant concedes that many conventional coupons have expiration dates printed on them as explained in the Background. But this is not a notification. A coupon bearing an expiration date as disclosed by Lemon et al. is no better than those coupons described in the Background of the claimed invention. In contrast, applicant's claimed invention provides a notification to a user of an expiration date of a coupon to help the user. Given the defects of Lemon et al., there is no benefit to combine Jones et al. with Lemon et al., which combination applicant specifically denies. Subsequently, the Office has failed to state either a *prima facie* case of anticipation or a *prima facie* case of obviousness.

The Office has conceded that "Jones fails to disclose providing an electronic notification related to the offered coupon." See page 11 of the first Office Action. That concession

conclusively indicates that there is no *prima facie* case of obviousness. But, the Office continued as follows:

Official Notice is taken it would have been notoriously well known to provide an electronic notification after a transaction of transferring data to notify and to ensure a receiver is aware that data has been transmitted. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include providing a electronic notification related to the offered coupon subsequent to the conducting the transaction to ensure the receiver is notified that the coupon has been sent and should have been received.

See page 11 of the first Office Action.

Applicant respectfully submits that in accordance with M.P.E.P. 2143.01, "the mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Given the concession by the Office that Jones et al. alone fails to disclose the claimed limitation, the claimed invention cannot be obvious. Furthermore, M.P.E.P. 2143.01 mandates that the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. Citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide a suggestion to combine the references.).

The Office has also sought to combine Jones et al., Lemon et al. and Wehmeyer. Because the combination of Jones et al. and Lemon et al. is defective, Wehmeyer cannot cure the defects of the combination, and thus there is no benefit combining Jones et al., Lemon et al. with Wehmeyer, which combination applicant specifically denies. Consequently, the Office has again failed to state either a *prima facie* case of anticipation or a *prima facie* case of obviousness.

The Office has also failed to show, and applicant is unable to find, where any of the cited and applied references, either alone or in combination, disclose "respond to a request received

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from a user in response to the information presented and allow the user to redeem the coupon on a channel different from the second channel," as recited in Claim 17. There are other claims which recite the "redeem" claimed limitation, such as Claims 15 and 16, albeit in different manners. The Office indicated that the "redeem" limitation is disclosed by the cited and applied references as follows:

Jones discloses the claimed machine-readable medium further includes instructions stored thereon to allow the user to redeem coupon on a channel different from the second channel (see col 2 line 63 - col 3 line 9) as the 'instructions' are inherent as necessary to perform the functions.

See page 5 of the first Office Action.

Applicant looks into Col. 2, line 63, to Col. 3, line 9, of Jones et al., and it discloses as follows:

The video signal representing the televised offer has embedded in it a token identifier. The token identifier may, for example, be embedded in a blanked line in the same manner as closed-captioning information. The token identifier is used as an index to retrieve the information for generating the token. This token information is either transmitted to the viewer's site or pre-stored in a memory at the user's site. In embodiments in which the token information is transmitted, it may be transmitted over a digital data communication channel that is distinct from the television channel, or it may be transmitted over the television channel by embedding it in the television signal along with the token identifier. The token information may include a bit-mapped image of the token.

See Col. 2, line 63 to Col. 3, line 9 of Jones et al.

Applicant has carefully studied this cited portion of Jones et al. and cannot find where redeeming of a coupon is discussed. One with ordinary skill in the coupon art would appreciate that redeeming is the act of removing an obligation by payment. Nothing of the sort can be found in Jones et al. The Office has further indicated that the claimed limitation "redeem" can be found at Col. 10, lines 16-30, of Jones et al.

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When coupon processor 98 has completed transferring the additional image information to image memory 118, coupon processor 98 provides a print signal 130 to a printer 132. Coupon processor 98 also deletes the coupon identification number from its memory. Printer 132 is preferably an economical thermal printer, but other types such as ink-jet printers, may also be suitable. Printer 132 has a roll of paper on which the coupon is printed. As the paper is advanced, the image is transferred in suitable groups from image memory 118 to printer 132 and printed. The resulting coupon will bear information identifying the product and the discount amount, the UPC bar-code, the demographic information bar-code, a date and time, and a cable company identification number. The television viewer can tear off the coupon when it has finished printing.

See Col. 10, lines 16-30, of Jones et al.

Nothing in that portion of Jones et al. has to do with redeeming a coupon. A coupon is described as being printed by Jones et al. but that is not redeeming. Perhaps, the Office is broadly interpreting the act of tearing off the coupon when Jones et al. has finished printing the coupon as equivalent to redeeming. But that sort of interpretation would be unreasonable. Redeeming a coupon is neither tearing the coupon off nor printing it. One with ordinary skill in the art would appreciate the difference between redeeming and tearing. Consequently, the Office has failed to state a *prima facie* case of anticipation.

The Office has further failed to show, and applicant is unable to find, where any of the cited and applied references, either alone or in combination, disclose "correlating information related to a television program on a first channel with information related to a coupon on a second channel, the information related to the coupon on the second channel including information related to a user," as recited in Claim 26. The Office indicated that the "information related to a user" limitation is disclosed by the cited and applied references as follows:

Jones discloses receiving coupons based on a request and demographic information. It is noted that the coupon information is 'related' to the user i.e. based on a request and/or demographic information (see col. 9, lines 3-47). It is further noted that since the coupon is sent to the requesting user,

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Jones discloses the claimed "wherein the information related to the user is obtained by obtaining a set top box identifier.

See page 6 of the first Office Action.

Jones et al. at Col. 9, lines 3-47, discloses as follows:

Coupon processor 98 receives the 256 bits of header field data 110 representing the demographic information and compares it to 256 bits received from a demographic switch 120. Demographic switch 120 is preferably a ROM. The switch settings or values of the individual bits provide information about the site at which subscriber unit 20 is installed and the consumers likely to be located there. The information may include whether the site is a home or business, the number of persons at that site, their ages and sexes, their consumption habits and the classes of products in which they would likely be interested. The bits may be organized into any suitable groupings. If coupon processor 98 detects a match, it provides a display signal 122 to a display 124. Like the caption "COUPON AVAILABLE" that is displayed on television 18, display 124 notifies the television viewer a coupon is available. If no match is detected display 124 remains blank or otherwise in its current state.

See Col. 2, line 63, to Col. 3, line 9, of Jones et al.

It is true that demographic information is discussed by Jones et al. at this cited portion but the demographic information pertains to a group of people. In contrast, the claimed limitation requires "information related to a user." It is difficult for the system of Jones et al. to distinguish one user from another user and so Jones et al. lumps all users associated with the subscriber unit into one. The problem is that the taste of a ninety-year old grandmother, using the remote of Jones et al. to print out a coupon, is likely to be different from the taste of a nine-year old teenage grandson who may cohabitate at the same site as the grandmother. Because Jones et al. utterly fails to disclose "information related to a user," among other limitations, the Office has failed to state a *prima facie* case of anticipation.

Therefore, applicant respectfully submits that a *prima facie* case of anticipation or obviousness has not been established by the Office, and the rejection should be withdrawn.

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Independent Claims 1, 17, 26, 37, and 41 are clearly and patentably distinguishable over the cited and applied references. Claims 2-6, 8-16, 18-20, 22-25, 27, 29, 30, 38-40, and 42-44 are allowable because they depend from allowable independent claims and because of the additional limitations added by those claims. Consequently, reconsideration and allowance of Claims 1-6, 8-20, 22-27, 29, 30, 37-44 is respectfully requested.

Respectfully submitted,

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Date: October 28, 2005

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